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Attorney Docket No.: 1405-1012

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Gregory J. Speicher  
Serial No.: 09/833,099  
Filed: April 20, 2001  
Art Unit: 2662  
Confirmation No.: 1374  
Examiner: Ricardo M. Pizarro  
For: Internet-Audiotext Electronic Advertising System with Psychographic Profiling and Matching  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Pre Appeal Brief Request for Review

Dear Sir:

This Request is being filed in connection with a Notice of Appeal.

Status

Claims 3-26 are presently pending of which claims 3, 11 and 19 are in independent form. (See 1/23/06 Response). Claims 3-4, 6-9, 11-12, 14-17, 19-20 and 22-25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,272,467 ("Durand") in view of U.S. Patent No. 5,848,396 ("Gerace"). Claims 5, 13 and 21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Durand in view of Gerace and in further view of U.S. Patent No. 5,950,200 ("Sudai"). Claims 10, 18, and 26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Durand in view of Gerace and in further view of U.S. Patent No. 5,835,087 ("Herz"). (See 5/17/06 Office Action).

Rejections Under 35 U.S.C. §103

The Examiner has rejected independent claims 3, 11 and 19 under 35 U.S.C. §103(a) as being unpatentable over Durand in view of Gerace. (See 5/17/06 Office Action).

**Independent 3, 11 and 19 are Patentable over Durand and Gerace**

Independent claims 3, 11 and 19 have been rejected as being obvious over Durand in view of Gerace, but these references, either alone or in combination, do not teach or suggest all the claim limitations recited in claims 3, 11 and 19 as required to establish a *prima facie* case of obviousness. (See MPEP §2143).

**Durand Fails to Teach at Least Four Limitations of Claims 3, 11 and 19**

The system of Durand provides a method for matching traits with corresponding preferences. The system of Durand utilizes two-way matching of selected criteria, which measures not only how compatible the potential match is with the desired traits of the user, but also how well the user fits the potential match's idea of the perfect match. In the primary embodiment, users of the system use touch-tone telephones to enter data into, and to respond to prompts from, the system over a telephone network. The primary embodiment of Durand is not suitable for user input or data entry requiring any degree of visual interaction. While Durand does disclose that compatibility matching services could be provided using access methods other than touch-tone telephones (Durant col. 5, ln. 67 - col. 6, ln. 8 & col. 18, ln. 48 - col. 19, ln. 3), Durand does not teach how, if at all, such an alternate implantation would differ from the described touch-tone telephone implementation.

Durand fails to disclose at least four limitations found in claims 3, 11 and 19. In fact, the Examiner has conceded that Durand fails to teach:

**Administering a test to a user via the Internet** (See 10/21/05 Office Action, page 3 & 5/17/06 Office Action, page 3)

**Administering a test to a user including presenting a set of visual images to the user and receiving the user's preferences based on the visual images** (See 10/21/05 Office Action, page 3)

In addition, neither the applicant nor the Examiner has identified within Durand any of the following explicitly-recited limitations of claims 3, 11 and 19:

**Generating a profile of a user based on the user's visual preferences** (See 1/23/06 Response, page 18)

**Matching a first set of users to a second set of users according to visual preferences** (See 1/23/06 Response, page 18).

Accordingly, there is no teaching or suggestion within Durand of at least four limitations explicitly recited in each of claims 3, 11 and 19.

**Gerace Fails to Teach at Least Four Limitations of Claims 3, 11 and 19**

Gerace discloses a method for targeting of commercial advertising based on the computer activity patterns of end users. A computer activity profile of a user is generated by recording the computer activity of a user over time. Categories of interest to the user are determined based on the user's activity. Using the activity profiles, commercial advertisements can be targeted to appropriate users. The Examiner has cited column 4 line 51 of Gerace for a teaching of "audio and video capabilities for a preferences monitoring being the Internet the network of choice." (See 5/17/06 Office Action, page 3). This portion of Gerace reads:

The program controller responds to commands (e.g., log in and menu selections) transmitted over the Internet by an end user, and obtains the necessary information from agate data assembly, user profiling member and advertisement module to generate and display appropriate screen views to the user.

While Gerace teaches the use of the Internet and the display of information in a visual format, Gerace is far afield from the claimed invention. (See 1/23/06 Response, page 19). Gerace fails to disclose at least four limitations found in claims 3, 11 and 19. Neither the applicant nor the Examiner has identified within Gerace any of the following explicitly-recited limitations of claims 3, 11 and 19:

**Administering a test to a first user including presenting a set of visual images to the first user and receiving the first user's preferences based on the visual images**

**Administering a test to a second user**

**Comparing the profile of the first user to the profile of the second user**

**Matching a first set of users to a second set of users according to visual preferences**

There is certainly no administration of a 'test' of any type in Gerace. To the contrary, the description of Gerace makes clear that the system disclosed therein is designed to not interfere with the user's normal interaction with his or her computer. There is also no teaching or suggestion of "comparing" profiles of different users or "matching" of users to one another. Accordingly, there is no teaching or suggestion within Gerace of at least four limitations explicitly recited in each of claims 3, 11 and 19.

**Neither Reference Teaches or Suggests Administering a Visual Preferences Test or Matching Users Based on Visual Preferences**

Neither Durand nor Gerace, either alone or in combination, teaches, suggests or discloses the following limitations:

**Administering a test to a user including presenting a set of visual images to the user and receiving the user's preferences based on the visual images (See 1/23/06 Response, page 20)**

**Matching a first set of users to a second set of users according to visual preferences (See 1/23/06 Response, page 20)**

In response to Applicant's argument that Durand fails to teach the above limitations, the Examiner has merely reiterated that Gerace teaches the receipt of user preferences, the generation of user profiles and the matching of users. (See 5/17/06 Office Action, page 3). Applicant does not contest that Durand teaches these general concepts. The Examiner is largely ignoring, however, the significance of matching based on "visual preferences," a concept which is recited throughout each of the claims. The Examiner has not identified any teaching of either of the above limitations within Durand.

In response to Applicant's argument that Gerace fails to teach the above limitations, the Examiner has answered merely that it would have been obvious to add the computer use tracking capability of Gerace to the teachings of Durand "to increase the chances of obtaining potential matches who are more compatible." (See 5/17/06 Office Action, page 3). While the Examiner appears to be stating that there would be a motivation to combine these references, The Examiner has not identified any teaching of either of the above limitations within Durand even in combination with Gerace.

**The Examiner has Failed to Establish a *Prima Facie* Case of Obviousness of Claims 3, 11 and 19**

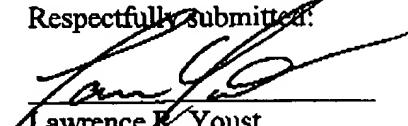
The Examiner has failed to provide any factual or analytical basis for the contention that the combination of Durand and Gerace teach or suggest either "administration" of a test of "preferences based on visual images" or "matching" one user to another user "according to visual preferences". Accordingly, the Examiner has failed to show that the combination of cited references teaches or suggests all the claim limitations of claims 3, 11 and 19, as required to establish a *prima facie* case of obviousness.

Conclusion

In view of the forgoing, the Panel is respectfully requested to allow independent claims 3, 11 and 19 as well as claims 4-10, 12-17 and 20-26 that are respectively dependent therefrom.

Dated this 17th day of August, 2006.

Respectfully submitted,

  
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